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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/407,053	09/27/1999	RICHARD L. PALINKAS	D-6394	2219

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3613

DATE MAILED: 03/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/407,053	PALINKAS, RICHARD L.
	Examiner Benjamin A Pezzlo	Art Unit 3613

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3-8,10-15 and 17-22 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,3-8,10-15 and 17-22 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Claim Objections

1. Claim 4 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The solid resilient spring of claim 4 is identical to the solid resilient material of the spring of claim 1.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 15 and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Carlston.

Carlston discloses a side bearing unit for a railroad car including a first housing 56 having a bore extending through the first housing, a first load bearing member coupled to the first housing (col. 3 lines 32-34) and defining an abutment surface opposite to the first housing, a second housing 32 having a bore extending through the second housing, adapted to telescopically receive the first housing, a second load bearing member 42 coupled to the second housing and defining an abutment surface opposite to the second housing (col. 3 lines 3-6 and col. 4 lines 34-36), and at least one compression spring in the shape of a torus positioned within the first

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housing bore, for providing a force resisting compression generally at an increasing rate when progressively compressed (see Fig. 3), thereby providing a low initial resistance to compression (see Fig. 3: see the low initial resistance associated with bearing compression from no compression to 0.625 inches of compression), but a high ultimate resistance to compression (see Fig. 3: see the resistance associated with bearing compression from 0.625 inches to 0.650 inches) in urging the first and second abutment surfaces away from each other in response to a load imposed on at least one of said abutment surfaces.

Re claim 19, see Carlston: springs 36, 38 in Fig. 2.

Re claim 20, see Carlston: "plate" 75 in Fig. 2.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-8, 10-14, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlston (US 4998997) in view of Magowan (US136079) in view of Platkiewicz (US 4465799) and further in view of Curtis (US 5036774) and Spencer et al. (US 5086707).

Carlston discloses a bearing pad assembly including a first housing 56 having an exterior surface and defining a bore extending at least part way through the first housing, a first load bearing member coupled to the housing (col. 3 lines 32-34) and defining an outwardly facing

first abutment surface and a second housing 32 defining a bore of a shape similar to the exterior surface of the first housing and adapted to slidably receive the first housing therein, a second bearing member 42 coupled to the second housing and defining an outwardly facing second abutment surface opposite to the first abutment surface (col. 3 lines 3-6 and col. 4 lines 34-36), and at least one compression spring 36 positioned within the first housing bore, wherein the compression spring comprises a resilient material having a torus shape for providing a force resisting compression generally at an increasing rate when progressively compressed (see Fig. 3), thereby providing a low initial resistance to compression (see Fig. 3: see the low initial resistance associated with bearing compression from no compression to 0.625 inches of compression), but a high ultimate resistance to compression (see Fig. 3: see the resistance associated with bearing compression from 0.625 inches to 0.650 inches) in urging the first and second load bearing members away from one another in response to a load being imposed upon at least one of the first and second abutment surfaces.

Carlston does not disclose the torus shaped compression spring being solid. Magowan discloses a solid toroidal compression spring. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a solid toroid according to the teachings of Magowan in an assembly according to Carlston in order to provide a biasing means with a high degree of elasticity but also with great economy and cheapness (Magowan: col. 1 line 9-13).

Carlston in view of Magowan do not disclose at least one slip lining positioned between the first housing exterior surface and a bore wall defining the second housing bore. Platkiewicz et al. disclose a low friction slide lining composition and a method of producing the slide lining

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composition. Curtis et al. disclose a long travel side bearing for an articulated railroad car, see Fig. 6, including spacers 64, 65 and Spencer et al. disclose self adjusting constant contact side bearings for railcars, see Fig. 4, including shims 100, 102. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a slip lining as taught by Platkiewicz et al. between the first housing and a bore wall defining the second housing bore in order to "improve utilization of slide surfaces" (Platkiewicz et al.: col. 1 lines 59-60). Curtis et al. and Spencer et al. provide further motivation to combine Carlston and Platkiewicz et al. Specifically, Curtis et al. teach that it is desirous to "permit sliding of the top cap member around the sleeve member" (Curtis et al.: col. 4 lines 66-68), and Spencer et al. teach that it is desirous to "automatically adjust and compensate for wear between cap and base parts" (Spencer et al.: col. 1 lines 57-58).

Re claim 3, see Fig. 3 of Carlston.

Re claim 4, see above.

Re claims 5-6, see Carlston: col. 2 lines 19-26.

Re claim 7, see Carlston: Fig. 6.

Re claim 8, see Carslton: Fig. 2.

Re claims 10-11, see generally Platkiewicz et al. col. 3 lines 2-6 and col. 1 lines 19-23.

Re claim 12, see generally Platkiewicz et al. col. 2 line 67, "rubbing pair". Also see MPEP 2144.04.VI.B: "Duplication of Parts", specifically, "the mere duplication of parts has no patentable significance unless a new and unexpected result is produced".

Re claim 13, see Platkiewicz et al. col. 3 line 63.

Re claim 14, see Platkiewicz et al. col. 3 line 64.

Re claim 17, see Carlston, Fig. 2.

Re claim 18, see Magowen, Fig. 2.

6. Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlston in view of Platkiewicz (US 4465799) and further in view of Curtis (US 5036774) and Spencer et al. (US 5086707).

Carlston discloses a side bearing unit for a railroad car including a first housing 56 having a bore extending through the first housing, a first load bearing member coupled to the first housing (col. 3 lines 32-34) and defining an abutment surface opposite to the first housing, a second housing 32 having a bore extending through the second housing, adapted to telescopically receive the first housing, a second load bearing member 42 coupled to the second housing and defining an abutment surface opposite to the second housing (col. 3 lines 3-6 and col. 4 lines 34-36), and at least one compression spring in the shape of a torus positioned within the first housing bore, for providing a force resisting compression generally at an increasing rate when progressively compressed (see Fig. 3), thereby providing a low initial resistance to compression (see Fig. 3: see the low initial resistance associated with bearing compression from no compression to 0.625 inches of compression), but a high ultimate resistance to compression (see Fig. 3: see the resistance associated with bearing compression from 0.625 inches to 0.650 inches) in urging the first and second abutment surfaces away from each other in response to a load imposed on at least one of said abutment surfaces.

Carlston does not disclose at least one slip lining positioned between the first housing exterior surface and a bore wall defining the second housing bore. Platkiewicz et al. disclose a

low friction slide lining composition and a method of producing the slide lining composition.

Curtis et al. disclose a long travel side bearing for an articulated railroad car, see Fig. 6, including spacers 64, 65 and Spencer et al. disclose self adjusting constant contact side bearings for railcars, see Fig. 4, including shims 100, 102. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a slip lining as taught by Platkiewicz et al. between the first housing and a bore wall defining the second housing bore in order to "improve utilization of slide surfaces" (Platkiewicz et al.: col. 1 lines 59-60). Curtis et al. and Spencer et al. provide further motivation to combine Carlston and Platkiewicz et al. Specifically, Curtis et al. teach that it is desirous to "permit sliding of the top cap member around the sleeve member" (Curtis et al.: col. 4 lines 66-68), and Spencer et al. teach that it is desirous to "automatically adjust and compensate for wear between cap and base parts" (Spencer et al.: col. 1 lines 57-58).

Re claim 22, see generally Platkiewicz et al. col. 2 line 67, "rubbing pair". Also see MPEP 2144.04.VI.B: "Duplication of Parts", specifically, "the mere duplication of parts has no patentable significance unless a new and unexpected result is produced".

Response to Arguments

7. Applicant's arguments filed 21 February 2002 have been fully considered but they are not persuasive.

Re claims 15, 19, 20, Applicant argues that Carlston's compression springs are not torus shaped, but rather, "C-shaped" about a central axis. Although Carlston's torus shaped springs

may be characterized as “C-shaped” insofar as they have only a torus shaped external profile, they are nonetheless torus shaped according to the claimed combination.

In further response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e. non C-shaped torus compression springs) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Moreover, and as indicated in the rejection, Carlston's spring behaves according to the manner claimed in claim 15, i.e., an increasing but initially low resistance which transitions ultimately to a high resistance.

Re claims 1, 3-8, 10-14, 17, and 18, Applicant argues that even though “solid” torus shaped compression springs are disclosed by Magowan, no motivation exists to substitute them for Carlston's compression springs. As indicated in the rejection, the motivation to use the springs of Magowan is that they provide an economical alternative to other types of compression springs. It is important to note also that Magowan does not disclose his spring as part of a bearing but rather by itself, perhaps, for use as a replacement part. He states specifically that his compression spring “may be applied with advantage to railway cars”. Carlston's bearing is for a railway car. Accordingly, it would have been obvious to one of ordinary skill in the art to which the invention pertains at the time the invention was made to have used a Magowan spring in a bearing according to Carlston.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin A Pezzlo whose telephone number is (703) 306-4617. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Dickson can be reached on (703) 308-2089. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 308-3519 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

BAP
March 8, 2002


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SUPERVISORY PATENT EXAMINER
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3/8/02